

## REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on June 20, 2005, the Examiner rejected claims 1-11 and 66-76.

### Rejections under 35 U.S.C. § 112

In the Office Action, the Examiner objected to claims 1-11 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully amend for clarity and traverse.

In claim 1 and claim 66, the phrase "total funds" has been amended to state "the funds." This phrase is supported by the Summary of the Invention as well as the Detailed Description of the Preferred Embodiments, page 18 lines 11-16 (Transactions occurring in virtual accounts are simultaneously debited or credited from funds in actual accounts.).

In claim 1, the phrase "said adjusted balance of said plurality of spending accounts" has been amended to state "said adjusted balance of the at least one of the plurality of spending accounts."

In claim 66, the phrase "said adjusted balance of said plurality of spending accounts" has been amended to state "said adjusted balance of the at least one of said plurality of allocation accounts."

### Rejections under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-11 and 66-76 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,745,706 to Wolfberg et al. (hereinafter

Wolfberg. The Examiner also indicated that the prior Official Notice was taken as admitted as prior art under M.P.E.P. § 2144.03. Applicants respectfully traverse.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

M.P.E.P. § 2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be found in the prior art, and not based on applicant disclosure. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). A clear and particular showing of the suggestion to combine is required to support an obviousness rejection under Section 103. *Id.*

The Examiner states that Wolfberg discloses a wireless communication for providing a plurality of spending accounts, invoices, spending limits, automatically adjusting a balance, and comparing balances. Applicants respectfully submit that this is somewhat of a misinterpretation of Wolfberg. Wolfberg relates to semi-automatic control systems for investment and spending account management.

Nothing in Wolfberg teaches “providing a plurality of spending accounts corresponding to an actual account” as required by independent claim 1. Instead, Wolfberg teaches individual spending or investment accounts to which the remainder of its teachings apply. The user of such accounts then supplies a deposit to the single account and is able to then spend from the account. (Col. 12, lines 17-27) The innovation of Wolfberg relates to providing warnings or messages to

the user to prompt action to comply with desired account performance. (Col. 12, lines 31-50)

Therefore, Wolfberg fails to teach the recited limitation from independent claim 1.

Furthermore, nothing in Wolfberg teaches managing a “job-based budget” based on the results of a comparison between the adjusted balance on a spending account to user-defined numerical spending limits as further required by independent claim 1. Rather, Wolfberg only teaches managing a simple actual account based on the balance and performance goals. (Col. 12, lines 17-27) Therefore, Applicants respectfully submit that, for at least these reasons, Wolfberg fails to teach or suggest all claim limitations of independent claim 1 as is required for a finding of obviousness under 35 U.S.C. § 103(a).

Similarly, Wolfberg also fails to teach “providing a funded actual account corresponding to plurality of job-based budget accounts, and a plurality of job-based allocation accounts corresponding to said plurality of budget accounts” as required by independent claim 66. Also, Wolfberg fails to teach managing a “job-based budget” based on comparison results as further required by independent claim 66 as discussed above. Applicants therefore submit that Wolfberg fails to teach or suggest all claim limitations of independent claim 66 for at least these reasons.

To the extent that the Examiner seeks to supplement Wolfberg based on Official Notice of Common Knowledge, Applicants respectfully submit that the Examiner has not properly relied on common knowledge, nor adequately defined what teachings are supposedly within common knowledge.

M.P.E.P. § 2144.03, to which the Examiner has cited, is specific as to when and how Official Notice of Common Knowledge may be taken. It states that notice “must be ‘capable of such instant and unquestionable demonstration as to defy dispute.’” (quoting *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970)) (emphasis added). The M.P.E.P. is also

quite specific when Official Notice may not be taken: “specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.” (citing *Ahlert* at 1091.) (emphasis added)

In the Office Action, the Examiner has not defined at all what teachings of the claimed invention are thought to be common knowledge. Therefore, Applicants respectfully submit that such undefined teachings are inherently incapable of demonstration at all, let alone instant and unquestionable demonstration such as to defy dispute. Indeed, referring to at least the quoted claim language above, the claim language refers to “specific knowledge” that the Examiner asserts is “of the prior art,” so according to M.P.E.P. § 2144.03, it must always be supported by citation to some reference work recognized as standard in the pertinent art and may not simply stand alone through Notice. Since the Examiner has not supported the assertion of common knowledge with a citation to a recognized reference work, Applicants respectfully submit that the reliance on common knowledge is inherently improper.

In the Office Action, the Examiner appears to rely on the Official Notice of Common Knowledge contained in the Office Action dated March 2, 2005. Applicants respectfully submit that the same noted difficulties exist with the Examiner’s prior Official Notice. In that Office Action, the Examiner Noticed that “the particulars of the job-based management of a business as recited in the claims, e.g. allocating, adjusting a balance of allocation accounts, comparing, accessing and managing . . . have been common knowledge in the job-based business art.” Applicants first respectfully submit that such general language fails to specifically indicate what is supposedly taught by common knowledge such that it is capable of instant and unquestionable demonstration such as to defy dispute. Instead, Applicants respectfully submit that it is incapable of demonstration.

Second, Applicants respectfully submit that in any case the Official Notice was improper at the time it was originally given according to M.P.E.P. § 2144.03, as noted above. Specific knowledge asserted to be of the prior art must always be supported by citation to an appropriately recognized reference work. Since no such reference was provided, even at the request of the Applicants in their response to the prior Office Action, the Applicants submit that such reliance on supposed common knowledge was improper.

Third, Applicants respectfully submit that, contrary to the Examiner's assertion in the Office Action dated June 20, 2005, the Applicants properly stated why the Office Action statements were not to be considered common knowledge in their Communication dated April 7, 2005. Therefore, the Applicants respectfully submit that the statements were improperly taken to be admitted as prior art under M.P.E.P. § 2144.03.

M.P.E.P. § 2144.03 is clear as to what is required to traverse a finding of common knowledge. Applicants' communication dated April 7, 2005 is clearly within what is required. In that communication, Applicants specifically disagreed with the Examiner taking Notice of manual practices:

Applicants disagree that all of the job-based accounting techniques claimed in the present invention are known in the field because of existing manual practices. The techniques used to efficiently implement job-based management on a wireless computer device are significantly different than the techniques used by hand. Therefore, the claimed inventions are not automatic implementations of the manual processes used for these accounting techniques. Rather, the claimed inventions are adaptation of job-based account management techniques that enable a user to obtain the results of manual job-based accounting in a more efficient manner.

(Page 9, emphasis added). Therefore, Applicants requested at that time that the Examiner "produce a specific reference for the concepts that are suggested to be well known in the field."

(Communication dated April 7, 2005, page 9) Contrary to the requirements of M.P.E.P. § 2144.03, the Examiner has failed to provide such references and has instead indicated that the

concepts are “taken to be admitted.” Applicants respectfully submit that such action is improper, renew their request that a specific reference for the concepts that are suggested to be well known in the field be provided, or request that the Official Notices of Common Knowledge be withdrawn. Applicants further submit that therefore the cited references fail to teach all the claimed limitations of their invention.

Fourth, Applicants respectfully submit that even if the prior and current Official Notices of Common Knowledge were proper, they still fail to teach all the claimed elements of the invention as disclosed in independent claims 1 and 66. Nothing in the Official Notices teach the claim limitations regarding a plurality of accounts corresponding to an actual account. Therefore, Applicants respectfully submit that the cited combination of Wolfberg and common knowledge fail to teach all the limitations of the claimed invention as disclosed in independent claims 1 and 66, as is required to sustain a finding of obviousness under 35 U.S.C. § 103(a).

Applicants also respectfully note that there is also no motivation to combine Wolfberg with the supposed common knowledge declared by the Examiner. As noted above, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). A clear and particular showing of the suggestion to combine is required to support an obviousness rejection under Section 103, and the suggestion must come from the prior art itself. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Applicants respectfully submit that the suggestion to combine provided by the Examiner is not clear and particular as required, nor contained in the (supposed) prior art.

In the Office Action, the Examiner indicates that the motivation to combine the supposed common knowledge with Wolfberg would have been to incorporate accounting terms and

techniques with the accounts of Wolfberg. Applicants respectfully submit that this is not a clear and particular showing of the suggestion to combine. First, as noted above, the Official Notices taken by the Examiner are unclear as to what is being noticed and therefore cannot provide a clear and particular showing of the suggestion to combine. Second, Applicants respectfully submit that the motivation to combine noted by the Examiner was not drawn from the prior art as required, but was generated by the Examiner. Third, Applicants respectfully submit that the fields of art between the two are significantly different and that the supposed suggestion to combine given by the Examiner fails to overcome the differences between the two. Investment managing and job-based budgeting are different fields with different techniques that do not lend to as simple cross-over as implied by the Examiner. Therefore, Applicants submit that there is no adequate motivation or suggestion to combine the supposed common knowledge with Wolfberg to arrive at the claimed invention as disclosed in claims 1 and 66.

For at least the above reasons, Applicants respectfully request that the rejections of independent claims 1 and 66 be withdrawn. Claims 2-11 and 67-76 depend on claims 1 and 66 and are thus allowable for at least the same reasons. Applicants respectfully request that the rejections of those claims be withdrawn as well.

Applicants sadly note that there appear to have been some misconstrued communications between the Applicants and the Examiner, desire to correct any misperceptions, and apologize that Applicants' communications appear to have been less than ideally clear to the Examiner. For example, in the Office Action, the Examiner notes that Applicants' referral to cancelled claim 29 was not the persuasive argument. Applicants respectfully note that the argument regarding claim 29 did not refer to Applicants' cancelled claim 29, but actually referred to claim

29 of Walsh (Communication dated April 7, 2005, page 9). Applicants also refer to the Examiner's apparent misunderstanding of the entire paragraph pointing out why the prior Office Action statements were not to be considered common knowledge or well known in the art (Communication dated April 7, 2005, page 9). Applicants appreciate the efforts of the Examiner regarding the instant application and sincerely hope to continue a good working relationship with the examiner.



### CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 8 day of July, 2005.

Respectfully submitted,



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